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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/878,908      | 06/19/97    | LAUTERJUNG           | K 09114/005001      |

QM32/0907

EXAMINER

PREBILIC, P

ART UNIT PAPER NUMBER

3738

*202*


DATE MAILED: 09/07/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

|                                      |                                   |   |
|--------------------------------------|-----------------------------------|---|
| Application No.<br><b>08/878,908</b> | Applicant(s)<br><b>Lauterjung</b> |   |
| Examiner<br><b>Paul Prebilio</b>     | Group Art Unit<br><b>3738</b>     |  |

### THE PERIOD FOR RESPONSE: [check only a) or b)]

- a)  expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b)  expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

(Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).


Applicant's response to the final rejection, filed on Jul 20, 2000 has been considered with the following effect, but is **NOT** deemed to place the application in condition for allowance:

- The proposed amendment(s):
  - will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - will not be entered because:
    - they raise new issues that would require further consideration and/or search. (See note below).
    - they raise the issue of new matter. (See note below).
    - they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - they present additional claims without cancelling a corresponding number of finally rejected claims.

### NOTE:

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

- Applicant's response has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
- Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
It is not persuasive in that Robinson and Lazarus rings or anchors are folded to the extent required by the claim language.
- The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):  
Claims allowed: 32, 33, and 36  
Claims objected to: \_\_\_\_\_  
Claims rejected: 21-25, 28, and 63-65
- The proposed drawing correction filed on \_\_\_\_\_  has  has not been approved by the Examiner.
- Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Other Upon filing an appeal, the rejection utilizing Kwan-Gett rejecting claims 63 and 64 will be applied against claim 65 because it is merely a rewrite of claim 64 in independent form. In addition the objection to claim 23 has been withdrawn but the objection to claim 64 and now 65 is maintained.

  
**PAUL PREBILIO**  
PRIMARY EXAMINER  
ART UNIT 3738

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Newly filed claims 52 and 53, with the amendment filed March 20, 2000, have been renumbered as claims 63 and 64 respectively because claim numbers 52 and 53 were previously used in amendment A filed June 1, 1998.

*Claim Objections*

Claims 23 and 64 are objected to because of the following informalities:

In claim 23, the language "the undeformed diameter" lacks antecedence.

In claim 64, it is not seen where this inherent feature has antecedent support from the specification which should set it forth and explain its origin.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 12, 13, 17, 19-25 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lazarus (WO 89/08433); see the whole document, especially page 8, lines 18-24 and Figures 2 and 3.

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With regard to claim 22 specifically, the Examiner posits that the claimed feature is inherently present in the Lazarus device because it depends upon how the device is placed within the body.

Claims 12, 13, 17, 19-25, and 28 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Robinson et al (US 5,733,325); see the whole document, especially the figures and the "Detailed Description of the Invention".

Claims 63 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Kwan-Gett (US 5,151,105) wherein elements 18 and 20 of Kwan-Gett are overlapping windings of resilient wire; see the whole document, especially Figures 2 and 7 as well as Col. 5, lines 19-31.

With regard to claim 64, the Examiner asserts that this is an inherent feature of wound rings verses solid rings of the same diameter based upon the additive verses exponential increase in strength based upon cross-sectional diameter.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarus (WO 89/08433) or Robinson et al (US 5,733,325) in view of Parodi (US 5,578,071). Lazarus

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and Robinson et al both independently meet the claim language as set forth above, but fail to make one end of the graft larger than the other end as claimed. Parodi, however, teaches that it was known to make one end of the graft larger than another when the graft is used in bifurcated region of the blood vessel to be repaired; see Figure 6 and the corresponding text therefor. Hence, it is the Examiner's position that it would have been obvious to make one end of the graft larger than the other so that the grafts of either Lazarus or Robinson et al could be used to repair a bifurcated blood vessel.

*Allowable Subject Matter*

Claims 32, 33, and 36 are allowed over the prior art of record. Leonhardt et al is similar to the claimed invention of these claims except is lacks a third and fourth prosthesis section telescopically engaging the second stent portion as claimed.

*Response to Arguments*

Applicant's arguments with respect to claims 12-15, 17, 19-25, and 28 have been considered but are moot in view of the new ground(s) of rejection. Specifically, Applicant amended claims to put the limitations of claims 16 and 26 into independent claims 12 and 21, but Applicant also deleted another limitation such that the claims are much broader in scope.

Applicant's arguments filed March 20, 2000, with respect to claims 63 and 64, have been fully considered but they are not persuasive. However, Kwan-Gett does disclose overlapping windings to form a ring bundle to the extent required by the present claims and the bundle is

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attached in a bundle form adjacent both free ends of the graft. To interpret Kwan-Gett as not having these features would not be reasonable and would not be giving the claims their broadest reasonable interpretation as the Examiner is charged to do.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703) 308-1065. The fax phone number for this Technology Center is (703) 305-3580.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
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